UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,506	07/02/2003	Motoaki Aoyama	KOT-0078	3507

23413   7590   03/18/2008

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ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
03/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 December 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.

    4a) Of the above claim(s) <u>16-42</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>13 December 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

- This office action is responsive to the following communication:

  Amendment filed on 12/27/2007.

- Claims 1-15 are currently pending in the application.

Priority

1.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Election/Restrictions

2.   Claims 16-42 are withdrawn from further consideration pursuant to 37 CFR

1.142(b) as being drawn to a nonelected invention, there being no allowable generic or

linking claim. Election was made **without** traverse in the reply filed on 12/27/2007.

Response to Arguments

3.   Applicant's arguments filed 09/06/2007 have been fully considered but they are

not persuasive.

4.   With respect to applicant's argument that Okimoto does not disclose a receiving

section to receive said electronic mail including image data and finishing information

representing a <u>post processing to be applied to said print product created on the basis</u>

<u>of said image data;</u>

In reply: Okimoto '926 teaches a receiving section (the mail reception system, col. 5, lines 25-35) to receive said electronic mail including image data (i.e., print data; col. 7, line 64) and finishing information (i.e., a process for reducing the size of a print pattern defined by one page's worth of print data so that reduced print patterns defined by more than one pages' worth of print data can be printed onto one sheet of paper; see col. 6, lines 64-67 and col. 26, lines 10-15, fig. 13, S982) representing a <u>post processing to be applied to said print product created on the basis of said image data</u> (a print process setting, col. 11, line 65 and col. 12, lines 20-25);

5.   With respect to applicant's argument that Okimoto does not disclose a finishing information judging section to determine <u>whether or not said post processing, represented by said finishing information, is provided in said image forming apparatus itself as an applicable post processing;</u>

In reply: Okimoto '926 teaches a finishing information judging section (Print Mail Reception Utility 31b, fig. 3) to determine <u>whether or not said post processing</u> (i.e., it is noted that when the present print mail reception utility process 31b is executed on the computer system 8 side, the process of S984 is executed to, judge whether the printer 6 is set to the page description language, a page description language (PDL) specifies the arrangement of a printed page through commands from a computer that the printer carries out, as determined in S982; see col. 22, lines 15-20, and fig. 14)<u>, represented by said finishing information</u> (i.e., it is noted that at least a process for reducing the size of a print pattern defined or data indicating whether the print data included in the attached

file is representative of a single color image or a full color image; see col. 6, lines 64-67

and col. 26, lines 10-15), is provided in said apparatus itself as an applicable post

processing (a print process setting, col. 11, line 65);

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-11, 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by

Okimoto et al. (US 6,268,926).

Regarding claim 1, Okimoto '926 discloses an apparatus (4, fig. 3) that receives

an electronic mail, so as to create a print product according to contents of said

electronic mail (i.e., the print mail reception utility 31b starts repeatedly requesting, at

predetermined time intervals, the POP server 38 to transfer mail addressed to the POP

client 36 from the mail spool 34; see col. 10, lines 28-35), said apparatus comprising:

a receiving section (the mail reception system, col. 5, lines 25-35) to receive said

electronic mail including image data (i.e., print data; col. 7, line 64) and finishing

information (i.e., a process for reducing the size of a print pattern defined by one

page's worth of print data so that reduced print patterns defined by more than one

pages' worth of print data can be printed onto one sheet of paper; see col. 6, lines 64-

67 and col. 26, lines 10-15, fig. 13, S982) representing a <u>post processing to be applied</u>

<u>to said print product created on the basis of said image data </u>(a print process setting,

col. 11, line 65 and col. 12, lines 20-25);

an acquiring section (Printer Driver 30, fig. 3) to acquire said image data (i.e., the

printer driver 30 is capable of creating print data, outputting the print data to the printer

6 to print the print data; see col. 8, lines 58-60) and said finishing information (reduced

print patterns defined, col. 6, line 66) <u>separately </u>from said electronic mail (POP Server

38, fig. 3);

a finishing information judging section (Print Mail Reception Utility 31b, fig. 3) to

determine <u>whether or not said post processing </u>(i.e., it is noted that when the present

print mail reception utility process 31b is executed on the computer system 8 side, the

process of S984 is executed to, judge whether the printer 6 is set to the page

description language, a page description language (PDL) specifies the arrangement of

a printed page through commands from a computer that the printer carries out, as

determined in S982; see col. 22, lines 15-20, and fig. 14)<u>, represented by said finishing</u>

<u>information </u>(i.e., it is noted that at least a process for reducing the size of a print

pattern defined or data indicating whether the print data included in the attached file is

representative of a single color image or a full color image; see col. 6, lines 64-67 and

col. 26, lines 10-15)<u>, is provided in said apparatus itself as an applicable post</u>

<u>processing </u>(a print process setting, col. 11, line 65);

a determining section (Transmission Command CPU 132, fig. 2b) to determine

whether or not said finishing information should be changed (i.e., It is noted that when

the present print mail reception utility process 31b is executed on the computer system

8 side, the process of S984 is executed to, judge whether the printer 6 is set to the

page description language as determined in S982; see col. 22, lines 15-20, fig. 14),

when said finishing information judging section determines that said post processing is

not provided in said apparatus itself (NO in S985, fig. 14);

a finish setting establishing section (Printer Selecting and Setting Process, fig.

14) to establish a set of finish setting to be applied to said print product based on a

result made by said determining section (Indicate in mail log that print mail is

unprintable S988, fig. 14).

Regarding claim 2, Okimoto '926 discloses the apparatus (4, fig. 3), wherein said

acquiring section (Printer Driver 30, fig. 3) includes an electronic mail analyzing section

(CPU 132, fig. 2b) to analyze said electronic mail so as to acquire said image data (i.e.,

the print mail transmission utility 31a is executed by the CPU 132 when a print mail

transmission instruction is issued from the printer driver 30; see col. 9, lines 1-5) and

said finishing information (Printer 6, fig. 3), separately from said electronic mail (POP

Server 38, fig. 3).

Regarding claim 3, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

a post processing content storing section (RAM 133, fig. 2b) to store content <u>of</u>

<u>post processing provided in advance </u>(a RAM 133 for preparing a storage area for

temporarily storing print data to be transmitted to a transfer destination; col. 8, lines 27-

30)<u> in said apparatus itself </u>(4, fig. 3)<u> as applicable post processing </u>(a print process

setting, col. 11, line 65).

Regarding claim 4, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein, when said finishing information judging section (Print Mail Reception

Utility 31b, fig. 3) determines that said post processing (a print process setting, col. 11,

line 65) <u>is provided in said apparatus itself </u>(4, fig. 3),<u> said finish setting establishing</u>

<u>section</u> (Printer Selecting and Setting Process, fig. 14) <u>establishes said set of finish</u>

<u>setting </u>(S984, fig. 14), <u>according to said finishing information directly acquired from said</u>

<u>electronic mail </u>(Select the Appropriate Printer for Print Output S987, fig. 14).

Regarding claim 5, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said electronic mail analyzing section includes a finishing information

rule storing section to store a rule with respect to a description of said finishing

information (i.e., the header 50b of the print mail further includes print information

(processing format data) such as an indicative rule of how the print data included in the

attached file is desired to be printed at the transfer destination; see col. 7, lines 53-60),

and analyzes said electronic mail data based on a content stored in said finishing

information rule storing section to acquire said finishing information, when analyzing

said electronic mail (i.e., file attributes such as a page description language (emulation),

at which the print data is described, and the number of sheets (finishing information),

onto which the print data is desired to be printed; see col. 7, lines 62-65).

Regarding claim 6, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said finishing information rule storing section stores a tag description

(i.e., the process in S982 may be modified to determine whether the mail header

includes processing format data indicating that the print data in the attached file is

representative of a full color image; see col. 26, lines 10-20) and said finishing

information while correlating them with each other (i.e., the file attributes as print

information, included in the mail header include codes indicative of the page description

language; see col. 26, lines 5-7).

Regarding claim 7, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

a notifying section to notify a sender of said electronic mail (Return to Sender

Specified in S630, fig. 11), when said finishing information judging <u>section determines</u>

<u>that said post processing is not provided in said apparatus itself</u> (i.e., if there exists no

printer having this function to interpret the page description language as determined in

S982 ("no" in S985), then in S988 a message is displayed in the mail log window 52

indicating that the current print mail is unprintable; see col. 22, lines 40-45, and fig. 14,

Print Mail is Unprintable S988).

Regarding claim 8, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said notifying section notifies said sender of a fact that said post

processing (Return to Sender Specified in S630, fig. 11), represented by said finishing

information (Printer Selecting and Setting Process, fig. 14), is not provided in said

apparatus itself as said applicable post processing (Indicate in mail log that print mail is

unprintable in S988, fig. 14), and of another applicable post processing corresponding

thereto (Switch printer setting to appropriate function in S986, fig. 14).

Regarding claim 9, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

a notifying section to notify a sender of said electronic mail of content (i.e., the

program determines in S993, based on the contents of its mail log data (mail header);

see col. 22, lines 53-55, fig. 15) of post processing applicable in said apparatus itself

(i.e., the page description language describing the subject print data is converted in

S995 so that print data equivalent to four pages before conversion is reduced to one

page of print data; see col. 23, lines 8-10, fig. 15).

Regarding claim 10, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said applicable post processing differs depending on a sender of said

electronic mail (i.e., the print mail is transmitted to a receiving end (transfer destination)

as specifically desired by a sender to be printed at the transfer destination. The cancel

mail is transmitted to the receiving end (transfer destination) of the print mail as

instructed by the sender to cancel printing of the print mail; see col. 7, lines 30-35).

Regarding claim 11, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising:

an individual-sender finishing content storing section to store identifying information for an individual-sender and a finishing content, which is allowed for said individual-sender, while correlating them with each other (i.e., the header 50b of the ordinary mail includes: a message ID identifying that mail; an address of a mail server (24 or 28) connected to the sender; an address of the transfer destination; a subject of the mail; and the like; see col. 7, lines 44-49, and fig. 18, Mail Structure).

Regarding claim 12, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising:

a sender rejecting section to stop an image-forming operation based on said image data included in said electronic mail, when an address of a sender coincides with a rejecting address established in advance (i.e., the cancel mail is transmitted by the mail server 24 to the Internet 28, along which the cancel mail is transferred until eventually arriving at the a destination. The computer system at the destination address will attempt to prevent the printing of the print mail indicated by the one or more cancel message IDs included in the cancel mail. The computer system will delete data of the print mail; see col. 14, lines 42-49).

Regarding claim 13, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising:

a sender restricting section to allow an image-forming operation based on said

image data included in said electronic mail, only when an address of a sender coincides

with an allowed address established in advance (i.e., the header 50b of the ordinary

mail includes: a message ID identifying that mail; an address of a mail server (24 or 28)

connected to the sender; an address of the transfer destination; a subject of the mail;

see col. 7, lines 46-49, and fig. 1).

Regarding claim 14, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

an image-forming section to conduct an image-forming operation based on said

image data (i.e., the process of S983 may be modified to set a printer, which is capable

of interpreting the page description language of the print data and which is capable

printing the color-printing type of the print data, to a function mode to interpret the page

description language of the print data and to print the print data at the corresponding

color-printing type; see col. 26, lines 35-40, and fig. 13).

Regarding claim 15, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

a finishing section to apply said post processing to said print product (i.e., the

print mail reception utility 31b is for receiving electronic mail addressed to the apparatus

4 and for executing processing operations in correspondence with the contents of the
mail; see col. 9, lines 5-10);

wherein said finishing section performs said-finish processing (Reduce 4 pages
of print data to 1 page in S995) based on said set of finish setting (i.e., a print process
setting; col. 11, line 65).

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure.

Kaufman et al. (US 7,126,716) discloses printer for printing labels, tags or the
like.

Maruyama (US 7,016,057) discloses electronic mail transmitting apparatus
having a printer driver for transmitting electronic mail and method for transmitting
electronic mail by a printer driver.

Wright (US 2005/0248792) discloses method and system of remote monitoring of
image forming apparatus.

Chapman et al. (US 6,522,421) discloses method and apparatus for
automatically communicating returning status and information from a printer using
electronic mail (email).

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ALLEN H. NGUYEN whose telephone number is

(571)270-1229. The examiner can normally be reached on M-F from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, King Poon can be reached on (571)-272-7440. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Allen H Nguyen/

Examiner, Art Unit 2625

08/10/2008

/King Y. Poon/

Supervisory Patent Examiner, Art Unit 2625